

1 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

2
3 APPL. NO.: 09/978,224)
4 APPLICANT: REUBEN BAHAR) Art Unit 2443
5)
6 FILED: 02/13/2003) Examiner: Asghar H. Bilgrami
7) Confirmation No. 4472
8 FOR: "METHOD AND SYSTEM) Attorney Docket No. 6589-A-7
9 CONFIRMING PROPER)
10 RECEIPT OF E-MAIL)
11 TRANSMITTED VIA A)
12 COMMUNICATIONS)
13 NETWORK")
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12 **FILED ON NOVEMBER 23, 2009 - VIA EFS**

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14 **REPLY BRIEF OF APPELLANT (SECOND APPEAL)**

15
16 Commissioner for Patents
17 P.O. Box 1450
18 Alexandria, VA 22313-1450

19 Sir:

20 This Reply Brief of Appellant is in support of the Notice of Appeal filed in the Patent
21 Office by the above-identified Applicant/Appellant (hereinafter, "Appellant") on May 4, 2009,
22 appealing the final rejection of the Examiner dated February 3, 2009, finally rejecting claims 184-
23 189, 191-213, 215-229, 231-234, 236-243, 248-255, 258-271, 279, 327-340, and 346-348. This
24 Reply Brief is also responsive to the Examiner's Answer mailed October 29, 2009. To the extent
25 that there are any fees payable for filing this Reply Brief, the Patent Office is hereby authorized to
26 deduct such fees from the Deposit Account of Cahill Glazer PLC, Account No. 030088.
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1 **Citation of 35 U.S.C. §101 in Examiner's Answer**

2 As indicated in Appellant's principal Brief, after receiving the final Office Action mailed
3 February 3, 2009, Appellant filed an Amendment After Final Rejection (May 4, 2009). The
4 Amendment filed May 4, 2009 amended independent claims 248 and 252 to cure formal defects
5 raised by the Examiner in the final Office Action under 35 U.S.C. §101. The Examiner issued an
6 Advisory Action Before the Filing of an Appeal Brief, mailed May 14, 2009, indicating that
7 Appellant's May 4, 2009 Amendment After Final Rejection had been entered. Within such
8 Advisory Office Action, the Examiner noted that the "remarks made on 5/4/2009 ... address the ...
9 101 deficiencies indicated in the final office action rejections ...".

10 The Examiner's remarks on page 3 of the Examiner's Answer regarding Section 101 seem
11 to overlook Appellant's Amendment After Final Rejection filed on May 4, 2009. Claim 248 was
12 already amended to recite "software on a computer storage medium ..."; claim 252 was already
13 amended to recite "software on a computer storage medium ...". These amendments are reflected
14 in the Claims Appendix attached to Appellant's principal brief, and the Examiner has noted that the
15 copy of the appealed claims contained in such Claims Appendix is correct.

16
17 **Citation of 35 U.S.C. §112 (second paragraph) in Examiner's Answer**

18 Appellant's Amendment After Final Rejection filed May 4, 2009 amended independent
19 claim 236 to address the Examiner's rejection of claim 236 under 35 U.S.C. §112, second
20 paragraph. The Advisory Action Before the Filing of an Appeal Brief mailed May 14, 2009
21 confirmed that Appellant's May 4, 2009 Amendment After Final Rejection had been entered, and
22 the Examiner's comments within such Advisory Office Action noted that the "remarks made on
23 5/4/2009 ... address the 112 second paragraph ... deficiencies indicated in the final office action
24 rejections ...".

25 The Examiner's remarks on page 4 of the Examiner's Answer regarding Section 112,
26 second paragraph, seem to overlook Appellant's Amendment After Final Rejection filed on May 4,
27

2009. Claim 236 was already amended to recite “receiving an e-mail at a recipient e-mail address”. This amendment is reflected in the Claims Appendix attached to Appellant’s principal brief, and the Examiner has noted that the copy of the appealed claims contained in such Claims Appendix is correct.

Section 103 Rejections

1. The Examiner’s Reliance Upon Flynn (U.S. Patent No. 6,618,747)

Within the Examiner’s Answer, at pages 12 and 14, the Examiner responds to arguments raised by Appellant with the counter-argument that the Examiner’s rejection of the claims is based upon three prior art references (i.e., Choi, Kanevsky, and Flynn), not just two (i.e., Choi and Kanevsky).

The independent claims that are on appeal are claims 236, 248, 252, 258, 260, 264 and 268. At page 6 of the Examiner’s Answer, addressing the rejection of such claims under Section 103, the Examiner states:

“Both Choi and Kanevsky did not explicitly disclose, (f) sending identifying data relating to the party associated with said access event for reference by a sending party to identify the party who accessed the e-mail.”

“In the same field of endeavor Flynn disclosed (f) sending identifying data relating to the party associated with said access event for reference by a sending party to identify the party who accessed the e-mail. (col.6, lines 53-56).”

Actually, as noted in Appellant’s principal brief at page 10, Kanevsky discloses a remote authentication process wherein the sender of an e-mail assigns an identity verification requirement (e.g. biometric identification) to an e-mail message; wherein the receiving party must identify himself/herself via a biometric attribute such as a fingerprint scan; and wherein such biometric data is then communicated back to the sender of the e-mail for verification against the sender’s database (see Kanevsky, at col. 6, lines 1-26). Thus, Flynn does not add to what was disclosed in Kanevsky. Appellant did not argue that Kanevsky fails to provide notification to the sender of the identity of the person who accessed the e-mail; rather, Appellant argued that Kanevsky fails to permit access

1 to an e-mail without first confirming that the user attempting access was the recipient intended by
2 the user.

3 Even when the teachings of Choi and Kanevsky are considered in further view of Flynn, the
4 invention recited by claims 236, 248, 252, 258, 260, 264 and 268 is still not obvious.
5 Appellant argued within his principal Brief that Kanevsky does not permit access to the e-mail
6 message unless either: 1) the sender grants to the recipient the right to access the first email
7 message after reviewing the credentials returned by the recipient and thereafter sending a second
8 message granting such access (so-called "remote user authentication"; see Kanevsky specification
9 at col. 6, lines 1-26); or 2) the sender attaches expected authentication data to the email message,
10 and the identification information entered by the recipient matches the expected authentication data
11 forwarded by the sender (so-called "local user authentication"; see Kanevsky specification at col.
12 6, lines 27-47). Appellant noted that Kanevsky is therefore contrary to the appealed claims, which
13 permit an e-mail to be accessed after a party associated with an access event inputs recipient data,
14 whether or not such party is the intended recipient. Appellant noted that the appealed claims do
15 not require that the sender first authenticate the recipient's identification, nor that a comparison be
16 made between identification information entered by the recipient versus identification information
17 expected by the sender, before permitting access to the e-mail message, as is true for Kanevsky.

18 The Examiner sets forth the basis for combining the teachings of Flynn with Choi and
19 Kanevsky at page 6 of the Examiner's Answer as follows:

20 "It would have been obvious to one in the ordinary skill in the art at the time the invention
21 was made to have incorporated sending identifying data relating to the party associated
22 with said access event for reference by a sending party to identify the party who accessed
23 the e-mail as disclosed by Flynn in a method of verifying whether e-mail was delivered to
24 the intended recipient as disclosed by Choi and Kanevsky in order to make the e-mail
delivery system more secure and protected by giving the sender the ability to know exactly
whether the e-mail content was delivered to the recipient resulting in assured and verified
communication between users on a network."

25 While not stated expressly in the Examiner's Answer, perhaps the Examiner is arguing that it
26 would have been "obvious" to modify Kanevsky based upon Flynn to eliminate any requirement

1 for either remote user authentication or local user authentication as a condition for allowing access
2 to the e-mail message. If this, indeed, is the Examiner's contention, then it would wholly
3 undermine the Examiner's statement that the motivation for combining such references is "... to
4 make the e-mail delivery system more secure and protected", and to achieve "... assured and
5 verified communication between users on a network." Kanevsky stresses that persons sending e-
6 mail messages "... often want the message to be retrieved and accessed by the intended recipient
7 and not made available to anybody else to access."; see Kanevsky, col. 1, lines 13-15. Indeed,
8 Kanevsky's primary objective is "... to provide a system and method for enabling a sender to
9 control access to e-mail and electronic information content after sending the e-mail message to an
10 intended recipient"; see Kanevsky, col. 1, lines 24-26 and 29-32.

11 If Kanevsky's method for controlling email access were modified, as proposed by the
12 Examiner, to permit access to an e-mail message by a user who has not been authenticated (either
13 remotely or locally), as appears to be the case in Flynn, then Kanevsky's primary objective is no
14 longer met. Such a modification of Kanevsky would be directly contrary to Kanevsky's teachings.
15 In addition, such a modification would make Kanevsky's e-mail system less secure, and less
16 protected, rather than making "the e-mail delivery system more secure and protected", as suggested
17 by the Examiner.

18 In summary, the Examiner has failed to show why Flynn would suggest to those skilled in
19 the art that the user authentication system disclosed by Kanevsky should be made less secure by
20 permitting access to an e-mail message by a user for whom such message was not intended.

21
22 Respectfully submitted,
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